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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,730	11/26/2003	Nicholas Frattalone	32958.00002	7353
29880 7590 10/30/2008 FOX ROTHSCHILD LLP PRINCETON PIKE CORPORATE CENTER 2000 Market Street Tenth Floor Philadelphia, PA 19103				
EXAMINER				
FELTEN, DANIEL S				
ART UNIT		PAPER NUMBER		
3696				
MAIL DATE		DELIVERY MODE		
10/30/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/722,730

**Applicant(s)**

FRATTALONE, NICHOLAS

**Examiner**

DANIEL S. FELTEN

**Art Unit**

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-6 and 10-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6 and 10-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI-108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Prosecution of this case is Re-opened based upon the Pre-Appeal Panel Decision August 01, 2008 so as to response to the applicant's challenge to the Examiner's Official Notice submitted October 19, 2005.

#### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 2, 4-6 rejected under 35 U.S.C. 101 because the process must be tied to another statutory class (such as a particular apparatus) or transform the underlying subject matter (such as an article or materials) to a different state of thing. In this case the recitation of a wireless communication network has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Furthermore, the limitations in the body of the claim are considered abstract mental steps that have no connection with a composition of matter (e.g., an article), but is concerned with a form of abstraction (terms within a offer/contract/lease) which is/are considered nonfunctional descriptive material (see MPEP 2106.01).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 4-6 and 10-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over SBA Communications Corporation Announces 2<sup>nd</sup> Quarter Results; Accelerates Tower Ownership (Aug. 14,1998), SBA website (sbasite.com) in view of Melone et al (US 2002/0138419) and Gross et al (US 2003/0225665).

SBA discloses, *as in claims 1 & 16-25*, a method for long-term leasing by a company of a plurality of properties, two or more of which are separately owned and each of which is with an area where wireless communications facility is needed for a wireless communication network and each of which contains a location desirable for positioning said facility (see SBA, “*site acquisition*”, “*site development*”, “*leasing negotiation*”, also see paragraph 4),

identifying two or more properties to acquire thorough lease (see SBA website “*site development*” and Article, paragraph 4); and

SBA discloses that it offers a broad array of site acquisition, zoning construction and tower space leasing services to the wireless communication industry comprising an offer to lease each property for a term of years (see Article, paragraph 4), but fails to disclose an offer to lease a property with a lump sum payment as consideration.

Melone discloses a method and system for structuring developing, administering and managing a lease transaction which allows a lump sum payment as consideration (see paras 0043-0044). Since the SBA provides a broad array of services that are customized to the clients needs (see Article paragraph 4), the lumpsum payment of Melone would be an obvious extension to the leasing services provided by SBA to provided greater flexibility and leverage (as enunciated in Melone) to accommodate the needs of their cusotmers. Thus, such a modification would provide SBA a broader customer base and increase the company's growth and profitability.

SBA fails to disclose, the specific leasing term (or offer) wherein the total rent is less than the aggregate projected period lease payments for each property over the term of use. Gross discloses a method for leasing properties wherein the total rent for a property is less than the aggregate period lease payment over the term of use (see Gross, paragraphs 0011-0017). It would have been obvious for an artisan to recognize the advantages of the aforementioned lease term to achieve the goals of growth and profitability mentioned above, as well as to achieve advantageous accounting treatment for the parties to the transaction where the transaction is structured to enable the lessee to achieve operating lease treatment, thereby avoiding adverse impact on the lessee's balance sheet and increasing ratings. The transaction is also advantageously structured to achieve leverage lease account treatment for the lessor, thereby providing favorable operating results on its reported financial statements (see Gross, *field of invention*, paragraph 0002). SBA, therefore would have recognized these advantages and used them to also provide mutually beneficial transactions between both parties as part of the lease negotiation process.

--wherein the properties are parcels on land (see SBA website and article), *as in claim 2*

--wherein at least one wireless communications facility is a part of a communications network (see SBA website and article), *as in claim 4*

--wherein said offer is to lease only a portion of each parcel of land comprising said desirable location, and any necessary access (see SBA website and article), *as in claim 5*

--wherein said offer is to lease said entire parcel of land (see SBA website and article), *as in claim 6*

--Re claims 10-15: the various forms of payment of the lump sum (*shorter term, undivided, in lieu of rent payments, cash, negotiable securities, etc.*) are well known in the art to make it convenient for transactions to take place between parties. Therefore OFFICIAL Notice is taken by the examiner of the aforementioned methods of payment being an obvious extension to the prior art SBA so as to provide a convenient (as well as conventional) transference of funds being well within the ordinary skill in the art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL S. FELTEN whose telephone number is (571)272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel S Felten  
Primary Examiner  
Art Unit 3696

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